



MS APPEAL BRIEF - PATENTS
Docket No.: 0465-1081P
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Jong Seok KIM et al.

Application No.: 10/720,077

Confirmation No.: 4939

Filed: November 25, 2003

Art Unit: 1746

For: DRUM TYPE WASHING MACHINE

Examiner: J. M. Heckert

APPEAL BRIEF TRANSMITTAL FORM

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Transmitted herewith is an Appeal Brief on behalf of the Appellants in connection with the above-identified application.

☐ The enclosed document is being transmitted via the Certificate of Mailing provisions of 37 C.F.R. § 1.8.

A Notice of Appeal was filed on August 24, 2007.

☐ Applicant claims small entity status in accordance with 37 C.F.R. § 1.27.

The fee has been calculated as shown below:

☒ Extension of time fee pursuant to 37 C.F.R. §§ 1.17 and 1.136(a) - \$120.00.

☒ Fee for filing an Appeal Brief - \$510.00 (large entity).

Application No.: 10/720,077

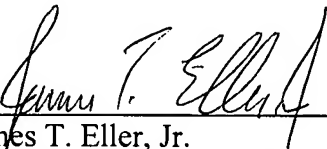
Docket No.: 0465-1081P

- ☐ Check(s) in the amount of \$\$630.00 is(are) attached.
- ☒ Please charge Deposit Account No. 02-2448 in the amount of \$630.00.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: November 26, 2007

Respectfully submitted,

By 
James T. Eller, Jr.
Registration No.: 39,538
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant

Attachments





Docket No.: 0465-1081P
(PATENT)

IN THE U.S. PATENT AND TRADEMARK OFFICE

Applicant: Jong Seok KIM et al. Conf. No.: 4939
Appl. No.: 10/720,077 Group: 1746
Filed: November 25, 2003 Examiner: J. M. Heckert
For: DRUM TYPE WASHING MACHINE

BRIEF ON APPEAL UNDER 37 C.F.R. § 41.37

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Sir:

As required under § 41.37(a), this Brief is filed within three months after the Notice of Appeal filed in this case on August 24, 2007, the time for filing the Brief being extended one month to expire on November 26, 2007, and is in furtherance of said Notice of Appeal.

The fees required under § 41.20(b)(2) are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

11/27/2007 SZEWDIE1 00000057 022448 10720077
01 FC:1482 510.00 DA

JTE/RJW/slb

This brief contains items under the following headings as required by 37 C.F.R. § 41.37 and M.P.E.P. § 1205:

- I. Real Party In Interest
- II. Related Appeals and Interferences
- III. Status of Claims
- IV. Status of Amendments
- V. Summary of Claimed Subject Matter
- VI. Grounds of Rejection to be Reviewed on Appeal
- VII. Argument
- VIII. Claims
- IX. Evidence
- X. Related Proceedings
- Appendix A. Claims
- Appendix B: Evidence
- Appendix C: Related Proceedings

I. Real Party in Interest

The real party in interest for this Application is LG Electronics Inc., as evidenced by an Assignment recorded on April 26, 2004 at Reel 015263, Frame 0653.

II. Related Appeals and Interferences

To the best of Appellants' knowledge, there are no other prior or pending appeals of this Application, or patent interference proceedings, or judicial proceedings which may be related to, directly affect, or be directly affected by, or have a bearing on the Board's decision of this Appeal.

III. Status of Claims

In the Application on appeal, claims 5-12 are the only pending claims. Claims 5 and 9 are independent. Claims 1-4 were previously canceled.

IV. Status of Amendments

The Amendment under 37 C.F.R. § 1.111, filed on March 14, 2007, has been entered as a matter of right and sets forth claims 5-12.

V. Summary of the Claimed Subject Matter

Claim 5 is directed to a drum type washing machine comprising a cabinet forming an exterior (element 52, shown in Figs. 2 and 3, and described in paragraph [0036], for example); a tub in the cabinet to hold water (element 56, shown in Figs. 2 and 3, and described in paragraph [0037], for example); a drum in the tub to hold a detergent and the water (element 62, shown in Figs. 2 and 3, and described in paragraph [0038], for example); a rotational shaft penetrating into the tub to be coupled with a rear side of the drum (element 58, shown in Fig. 2 and described in paragraph [0038], for example); a motor transferring a driving force to the rotational shaft (element 60, shown in Fig. 2 and described in paragraph [0041], for example); and a damper provided between the tub and the cabinet to attenuate vertical, horizontal, and front-to-rear vibrations transferred to the tub by a rotation of the drum (element 90, shown in Figs. 2-4, and described in paragraphs [0042] – [0049], for example), the damper comprising first and second dampers provided at left and right sides under a bottom of the tub to attenuate the vertical and

horizontal vibrations (elements 91a and 91b, shown in Fig. 3 and described in paragraphs [0045]-[0047], for example); and a third damper provided in rear of the tub to attenuate the front-to-rear vibration (element 92, shown in Figs. 3 and 4, and described in paragraphs [0045] – [0047], for example).

Claim 8 depends from claims 5, 6 and 7 and further recites that each damper is hinge-coupled to the cabinet (elements 99 and 96, shown in Fig. 4, and described in paragraphs [0053]-[0054], for example).

Claim 9 is directed to a damper of a drum type washing machine, comprising first and second dampers provided at left and right sides under a bottom of the tub to attenuate the vertical and horizontal vibrations (elements 91a and 91b, shown in Fig. 3 and described in paragraphs [0045]-[0047], for example); and a third damper provided in rear of the tub to attenuate the front-to-rear vibration (element 92, shown in Figs. 3 and 4, and described in paragraphs [0045] – [0047], for example).

Claim 12 depends from claims 9, 10 and 11 and further recites that each damper is hinge-coupled to the cabinet (elements 99 and 96, shown in Fig. 4, and described in paragraphs [0053]-[0054], for example).

Appellant respectfully submits that claims 8 and 12 patentably define over claims 5 and 9, from which they respectively depend, because of the hinge coupling feature recited in claims 9 and 12 and, thus, that claims 8 and 12 do not stand or fall together with claims 5 and 9.

VI. Grounds of Rejection to be Reviewed on Appeal

Claims 5-7 and 9-11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,158,257 to Ryan et al. (“Ryan”). The Office Action admits that Ryan does not disclose the dampening device arrangement recited in claim 5, i.e., a damper comprising (1) first and second dampers provided at left and right sides under a bottom of the tub to attenuate the vertical and horizontal vibrations; and (2) a third damper provided in the rear of the tub to attenuate the front-to-rear vibration. However, the Office Action cites *In re Japikse*, 86 USPQ 70 (CCPA 1950), for the proposition that rearrangement of parts was held to have been obvious, states that Ryan already discloses multiple dampers, and concludes that it would have been obvious to arrange them in whatever fashion yields the most efficient dampening effect.

VII. Argument

In rejecting claims under 35 U.S.C. § 103, it is incumbent on the Examiner to establish a factual basis to support the legal conclusion of obviousness. See *In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have

been led to modify the prior art or to combine prior art references to arrive at the claimed invention.

Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. *See Uniroyal Inc. v. F-Wiley Corp.*, 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), *cert. denied*, 488 U.S. 825 (1988); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), *cert. denied*, 475 U.S. 1017 (1986); *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933. The Examiner may not pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. *See Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve Inc.*, 796 F.2d 443, 448, 230 USPQ 416, 419 (Fed. Cir. 1986), *cert. denied*, 484 U.S. 823 (1987) and *In re Kamm*, 452 F.2d 1052, 1057, 172 USPQ 298, 301-2 (CCPA 1972). Obviousness cannot be established by locating references which describe various aspects of Applicants' invention without also providing evidence of the motivating force which would impel one skilled in the art to do what Applicants have done. *See Ex parte Levengood*, 28 USPQ2d 1300, 1302 (Bd. App. & Int. 1993). These showings by the Examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. These showings must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." *See In re Dembiczak*, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999). *See, also, In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *See In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. *See In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. *See In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Moreover, a factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusory statements of the Examiner. *See In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

The Office Action admits that Ryan does not disclose the dampening device arrangement recited in claim 5, i.e., a damper comprising (1) first and second dampers provided at left and right sides under a bottom of the tub to attenuate the vertical and horizontal vibrations; and (2) a third damper provided in the rear of the tub to attenuate the front-to-rear vibration.

In an attempt to remedy this deficiency, the Office Action turns to case law that does not apply to the facts at hand. The Office Action cites *In re Japikse*, 86 USPQ 70 (CCPA 1950) for the proposition that rearrangement of parts was held to have been obvious. Appellants respectfully disagree with the statement of the holding in this case and assert that it is also improperly applied to the facts at hand.

A reading of the *Japikse* case reveals that Japikse claimed a hydraulic power press. Claim 3 of Japikse allegedly read on the Cannon reference except for the feature, “means

disposed in alignment with said opening for contact by said depending means to start the pressing operation of said hydraulic press.” The Board held that there would be no invention in shifting the starting switch disclosed by Cannon to a different position since the operation of the device would not thereby be modified (emphasis added). The Court found no error in that holding of the Board.

In the first place, Appellants respectfully submit that it is completely improper to base a rejection on the broad, general principle quoted above, which is incorrect in the sense that it does not address a rearrangement that affects the operation of Ryan’s specific device, and is not clear and particular objective factual evidence which would motivate one of ordinary skill in the art to modify Ryan to redesign and reconstruct Ryan to provide the claimed damper structure. *See* in this regard, the aforementioned case law including *In re Lee* and *In re Dembiczak*. Moreover, this approach does not address the invention as a whole, as required by the decision in the previously cited *Graham v. John Deere* case. Evidence of this is in the language found in this case, which is eschewed by subsequent case law, i.e., “there is no invention in.” That is not the standard for evaluating obviousness of an invention under the subsequently enacted 1952 Patent Act.

Relying on such a statement is inconsistent with the principles set down by *Graham v. John Deere* and *In re Lee* and *In re Dembiczak* and makes this rejection fundamentally improper.

Moreover, the reliance on the stated holding in this pre-1952 Patent Act case provides no objective evidence of the desire of one of ordinary skill in the art to redesign the fundamental structure of Ryan in such a counter-intuitive manner, i.e., replacing two fixed, non-hinged, dampers, one located in front of the tub, the other being located behind the tub, connected to the

top of the cabinet, with the claimed three element damper structure, two of which are provided at right and left sides under a bottom of the tub and a third located in the rear of the tub.

Additionally, the Office Action fails to explain how this fundamental redesign of Ryan which deals with the operational aspects of Ryan's device, relates to locating a power switch for a hydraulic press that had no effect on the operation of the hydraulic device in issue in *Japikse*.

Because Ryan fails to disclose the recited damper structure feature which affects the operation of the claimed invention, and no objective evidence is shown of such a feature existing in the art, this rejection must be based on improper speculation and/or impermissible hindsight.

Furthermore, the Office Action relies upon the assertion that rearrangement of parts was held to have been obvious as establishing a *per se* rule that any modification of a reference is obvious simply by citing the *In re Japikse* decision and stating that that case held rearrangement of parts was obvious. As noted above, no direction is given to a skilled worker of why the claimed damper structure should be preferred. Moreover, as stated by the Federal Circuit in *In re Ochiai*, 71 F.3d 1565, 1572, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995), "reliance on *per se* rules of obviousness is legally incorrect and must cease."

Ryan's tub is suspended from cabinet 16 by a plurality of subassemblies 18 and 20, each of which includes a cylinder 44, a rod 46, a piston 48 and a spring 50. Ryan's disclosed embodiments only have two suspension subassemblies 18 and 20, one of which is located at the top rear of tub 14, and the other of which is located at the top front of tub 14. Ryan does state that preferences for the exact number of tub suspension subassemblies and the location of their attachment location points to the cabinet may be determined by computer simulation and/or

experiment (paragraph bridging cols. 3 and 4), but fails to provide any details of a computer simulation or of the experimental conditions that will necessarily lead to the claimed invention. Moreover, the only direction presented by Ryan in this regard is to avoid exciting any natural frequencies and to reduce any initial transient during the spin-dry and washing cycles. However, the Office Action completely fails to demonstrate by objective factual evidence that avoiding exciting any natural frequencies or reducing any initial transient during the spin-dry and washing cycles is what is in issue in the claimed invention or what is addressed by the claimed invention.

Ryan is completely devoid of any disclosure whatsoever of distinguishing between a specific suspension assembly located in specific positions directed to attenuating both horizontal and vertical vibrations of the tub, and a separate specific suspension subassembly located in a particular position directed to attenuating front-to-rear vibrations of the tub. Without such directions, one of ordinary skill in the art cannot reasonably be expected to arrive at the claimed invention. This is not a situation, for example, where optimum values of a disclosed material are being determined using routine experimentation, for example, but a situation where Ryan, the only reference being used to reject these claims, contains no disclosure whatsoever of a specific suspension assembly located in specific positions directed to attenuating both horizontal and vertical vibrations of the tub, and a separate specific suspension subassembly located in a particular position directed to attenuating front-to-rear vibrations of the tub.

Appellants respectfully submit that Ryan has no concept of attenuating those specific vibrations using that particular structure.

Accordingly, the Office Action fails to make out a *prima facie* case of obviousness of the claimed invention.

Reconsideration and reversal of this rejection of claims 5-7 and 9-11 are respectfully requested.

Claims 8 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ryan in view of U.S. Patent 5,907,880 to Durazzani et al. ("Durazzani"). This rejection is respectfully traversed.

Appellants respectfully submit that this rejection is moot with respect to claim 4, which has been canceled.

Claims 8 and 12 depend from claim 5, and the Office Action fails to make out a *prima facie* case of obviousness of claim 5 based on Ryan for the reasons stated above. Moreover, Durazzani is not applied to remedy the aforementioned deficiencies of Ryan. So, even if one of ordinary skill in the art were properly motivated to modify Ryan in view of Durazzani, as suggested (which is not the case for the reasons discussed below), the resulting modified version of Ryan would neither render moot nor render obvious the claimed invention.

The Office Action also fails to provide objective factual evidence that one of ordinary skill in the art would turn to Durazzani to modify Ryan, as suggested. Ryan clearly discloses that its non-hinged suspension subassemblies 18 and 20 are "softer" (more compliant) than conventional tub suspension subassemblies. This is reason enough not to turn to Durazzani to modify the more compliant subassemblies of Ryan which, as clearly shown in Fig. 1 of Ryan, do not include hinges, or show a rigid coupling scheme, or connect pistons 48 to the drum. In fact, this improved, softer,

more compliant structure taught by Ryan is reason for one of ordinary skill in the art not to turn to Durazzani to modify Ryan to arrive at the claimed invention.

Accordingly, the Office Action fails to make out a *prima facie* case of obviousness of the claimed invention recited in claims 8 and 12.

Reconsideration and reversal of this rejection of claims 8 and 12 are respectfully requested.

VIII. CLAIMS

A copy of the claims involved in the present appeal is attached hereto as Appendix A. As indicated above, the claims in Appendix A do include the amendments filed by Appellant on March 14, 2007.

IX. EVIDENCE

No evidence pursuant to §§ 1.130, 1.131, or 1.132 or entered by or relied upon by the Examiner is being submitted.

X. RELATED PROCEEDINGS

No related proceedings are referenced in Section II, above.

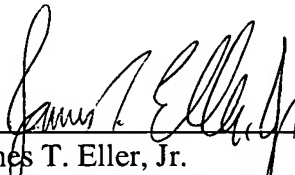
CONCLUSION

Appellant respectfully submits that claims 5-12 are patentable over the applied art and that all of the rejections of record should be reversed.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17, particularly extension of time fees.

Dated: November 26, 2007

Respectfully submitted,

By 

James T. Eller, Jr.
Registration No.: 39,538
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Rd
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Appellants

APPENDIX A: CLAIMS

5. (Previously Presented) A drum type washing machine comprising:
- a cabinet forming an exterior;
 - a tub in the cabinet to hold water;
 - a drum in the tub to hold a detergent and the water;
 - a rotational shaft penetrating into the tub to be coupled with a rear side of the drum;
 - a motor transferring a driving force to the rotational shaft; and
 - a damper provided between the tub and the cabinet to attenuate vertical, horizontal, and front-to-rear vibrations transferred to the tub by a rotation of the drum, the damper comprising:
 - first and second dampers provided at left and right sides under a bottom of the tub to attenuate the vertical and horizontal vibrations; and
 - a third damper provided in rear of the tub to attenuate the front-to-rear vibration.
6. (Original) The drum type washing machine as claimed in claim 5, wherein each of the first to third dampers comprises a cylinder and a piston inserted in the cylinder to reciprocate.
7. (Original) The drum type washing machine as claimed in claim 6, wherein a cylinder holder is provided at one end of the cylinder to be coupled with the tub and a piston holder is provided at one end of the piston to be coupled with the cabinet.

8. (Original) The drum type washing machine as claimed in claim 7, wherein the cylinder and piston holders are hinge-coupled with fixing ends provided at the tub and cabinet, respectively.

9. (Original) A damper of a drum type washing machine, comprising:
first and second dampers provided at left and right sides under a bottom of the tub to attenuate the vertical and horizontal vibrations; and
a third damper provided in rear of the tub to attenuate the front-to-rear vibration.

10. (Original) The damper as claimed in claim 9, wherein each of the first to third dampers comprises a cylinder and a piston inserted in the cylinder to reciprocate.

11. (Original) The damper as claimed in claim 10, wherein a cylinder holder is provided at one end of the cylinder to be coupled with the tub and a piston holder is provided at one end of the piston to be coupled with the cabinet.

12. (Original) The damper as claimed in claim 11, wherein the cylinder and piston holders are hinge-coupled with fixing ends provided at the tub and cabinet, respectively.

APPENDIX B: EVIDENCE

(None)

APPENDIX C: RELATED PROCEEDINGS

(None)